

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

REMARKS

Claims 1-21 are pending in this application. Attached hereto is a complete listing of all claims in the application, with their current status listed parenthetically.

Declarations in Support of Traversal

Attached hereto are two declarations under 37 C.F.R. 1.132 in support of traversal of rejections under 35 U.S.C. 112 1st paragraph. These declarations are timely since they are filed concurrently with a Request for Continued Examination. See M.P.E.P 716.01(A)(4)

Rejection Under 35 U.S.C. § 112, 1st paragraph (no enablement)

In the 1st paragraph of the Office Action, the Examiner rejects claims 1-22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner provides an analysis of the determining factors for undue experimentation. As discussed below, the Applicant respectfully traverses the rejection.

A. The claims are enabled by the Specification

Before entertaining a discussion as to the amount of experimentation required, the Examiner is reminded that "[a]s long as the specification

Response to Office Action and Request for Reconsideration

discloses at least one method for making and using the claimed invention that bears reasonable correlation to the entire scope of the claim, the enablement requirement is met." M.P.E.P § 2164.01(b)

Claim 1	Claim element	Exemplary Embodiment
Preamble	A method for enabling two-way asynchronous communication between a client and a web server to occur using a single HTTP transaction, the method comprising:	Summary of the Invention "The invention, relates to a system and method for maintaining direct, two-way asynchronous communication between a client and a web server"
1a	opening, by the client, one socket connection to the web server;	"The system 100 illustrates only one socket connection between a single client 102 and a single host 120." (Page 4, line 3-4)
1b	communicating an HTTP request from the client to the web server over the one socket connection as part of the single HTTP transaction, wherein the HTTP request is a request for the web server to initialize a CGI that operates within or in conjunction with the web server;	"According to one embodiment of the invention, a CGI is invoked in response to HTTP request passed from the client 102 to the web server 122 and on the CGI." (Page 5, lines 3-4)
1c	initializing, by the web server, the CGI after receiving the HTTP request from the client;	"The initial HTTP request identifies to the web server, which CGI to invoke." (Page

		5, lines 4-5)
1d	executing, by the CGI after the CGI has been initialized, operations to enable the two-way asynchronous communication between the client and the web server to occur over the one socket connection and wholly within the single HTTP transaction until the CGI operations are terminated by the client or the CGI; and	<p>"The CGI, according to an exemplary embodiment of the invention, is configured to perform operations that include continuous, two-way asynchronous communication of data between the client 102 and the CGI." (Page 5, lines 5-8)</p> <p>"In an exemplary embodiment, the task of performing two-way asynchronous communication is accomplished within a single HTTP transaction" (Page 6, lines 9-10)</p> <p>"Thus, in accordance with the invention, the CGI will continue until notified by the client." (Page 6, lines 12-13)</p>
1e	closing, by the web server, the one socket connection after the CGI operations have been terminated;	"At step 250, upon termination of the CGI, the socket is closed" (Page 6, lines 13 -14)
1f	wherein the two-way asynchronous communication between the client and the web server over the one socket connection and wholly within the single HTTP transaction allows for sending of particular information from the web server to the client and	"In one particular embodiment, the information <u>sent or received</u> by the CGI is compliant with a protocol other than HTTP." (Page 5,

	for sending of information from the client to the web server; said particular information and said information being communicated in a protocol other than HTTP; and wherein the web server is able to send the particular information to the client without receiving a request from the client for the particular information.	lines 28-29) "When the information is available, as shown with step 242, the information is sent to the client at step 232. The second operation continually repeats until the CGI is terminated..." (Page 5, line 34 – Page 6, line 1)
--	--	---

It is respectfully submitted that the above exemplary embodiments, disclosed in the specification, clearly bear reasonable correlation to the entire scope of the claim. It is additionally submitted that the other independent claims 9, 20, and 21 include similar elements, limitations, and are of similar scope. Since the dependent claims further refine and limit the scope of the independent claims, it is respectfully submitted they are additionally enabled by the specification. The Applicant therefore respectfully requests the Examiner reconsider and withdraw the rejection on this basis alone.

B. The specification enables one of ordinary skill to make and use the invention without undue experimentation.

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

In the Office Action the Examiner provides an analysis of the “undue experimentation factors” and asserts the amount of experimentation required would be “undue”. As discussed below, the Applicant respectfully traverses this rejection.

(1) Breadth of the Claims: The Examiner concludes the claims are “Broad” based on a review of claim scope. The Examiner states:

“As to the breadth of the claims, the claims are broad. Essentially all particular implementations for performing two-way asynchronous communications between a client and a server fall within the scope of the claims.”

While the Applicant has claimed the scope commensurate with that of the specification, the Examiner has failed to consider the entirety of the claims. For example, claim 1 includes the limitation that the two-way asynchronous communications take place within a “single HTTP transaction”. The Examiner is reminded that “the examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually.” M.P.E.P. § 2164.08. (Emphasis added)

Further, the Examiner’s assertion is misplaced as to the scope. see Expert Declaration of Mr. Brad Tipler. When the independent claims

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

are considered as a whole, the Examiner's comment unduly characterizes the scope of the claims.

In the Final Office Action the Examiner further states:

"The Examiner fails to see the relevance of what appears to be an argument regarding the *scope of enablement* to a rejection that there is *no enablement*."

The Examiner is respectfully invited to read section 2164.08 of the M.P.E.P., paying particular attention to the discussion in the third paragraph. It states:

"As concerns the breadth of a claim relevant to enablement the only relevant concern should be whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought." (Emphasis added)

Of further importance to the present application is found in the second paragraph where it states:

"Nevertheless not everything necessary to practice the invention need be disclosed. In fact, what is well known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). All that is necessary is that one of ordinary skill in the art be able to make and use the invention, given the level of knowledge and skill in the art. Further the scope of enablement must only bear 'reasonable correlation' to the scope of the claims. See e.g., *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)" (Emphasis added)

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

Here, the Scope of the Claim is appropriate with the level of enablement taught in the application. see above chart, see a/so Expert Declaration of Mr. Tipler. Further, the level of detail sought by the Examiner in the statement "the application only generally describes the functions the client side logic performs but provides no details on the particular software constructs that would be used to implement those functions," seems to ignore the courts guidance that "[n]evertheless not everything necessary to practice the invention need be disclosed. In fact, what is well known is best omitted." (emphasis added) Especially in light of Shishig Gundavaram's statement in 1996 that "CGI isn't magic, it's just programming with some special types of input and a few strict rules on program output." (emphasis added) Exhibit G to Expert Declaration of Mr. Brad Tipler.

As clearly illustrated above the scope of the claims is appropriate. The level of enablement sufficient to allow one of ordinary skill to make and sue the invention without undue experimentation. This factor suggests the level of experimentation is not undue.

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

(2) Nature of the Invention:

The Applicant notes that the Examiner analysis of this factor was to acknowledge that the newer technology addressed in the present application involves a computer protocol specified as HTTP. Provided herewith for the Examiner's consideration is a copy of a draft specification of HTTP 1.0. (Exhibit of the Expert Declaration of Mr. Tipler) Of particular interest is the date of this document February 19, 1996. Mr. Tipler's declaration clearly illustrates that the nature of this invention was in a field well known to those of ordinary skill when the Applicant invented the claimed invention. Applicant suggests that the invention, and the claims, are drawn to novel, non-obvious techniques within a very well known area.

This factor suggests the level of experimentation is not undue.

(3) State of the Prior Art:

The Applicant submits that the Examiner's analysis under state of the prior art is misdirected. In the Office Action the Examiner states:

"[T]he very features that the applicants argue distinguish the claims from the prior art are those not described. A search of the prior art has not disclosed a system as claimed for performing two-way asynchronous communication between a client and a server within a single HTTP transaction."

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

and

"The Examiner fails to how [sic] it is unreasonable to expect the applicants to provide more explanation of the features that distinguish the claims from the prior art."

The Examiners statement that the prior art has not shown the claimed elements, while accurate is misguided under this factor. The Examiner is respectfully referred to the above "Nevertheless not everything necessary to practice the invention need be disclosed. In fact, what is well known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). (emphasis added) and "CGI isn't magic, it's just programming with some special types of input and a few strict rules on program output." (Emphasis added). Further, If the Examiner had found prior art disclosed a system as claimed for performing two-way asynchronous communication between a client and a server within a single HTTP transaction, the Applicant would have expected a rejection on the basis of that art. This in no way implies that the state of the prior art is deficient. It only implies that the present invention is truly novel and non-obvious in an arena where the knowledge and skill of those in the art is significant. This factor suggests the level of experimentation is not undue.

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

(4) Level of Ordinary Skill: In the Final Office Action the Examiner asserts that "mere attorney argument is given little weight." The Applicant additionally asserts the level of ordinary skill in the art at the time of the invention was high. The filing date of the application was January 19, 2001. The state of the art, and the level of one of ordinary skill was significant. By January 2001, the Internet had made a significant impact on society, the number of persons skilled in the art was substantial, and the level of programming skills of those involved in "the new economy" was significant. This assertion is further supported by the Expert Declaration of Mr. Tipler, and the supporting evidence therein. This factor suggests the level of experimentation is not undue.

(5) The level of Predictability in the Art:

Applicant notes with appreciation the Examiner's correct assessment that the computer arts are generally considered predictable. This factor is further addressed in the Expert Declaration of Mr. Tipler. The Applicant agrees with the Examiner that this factor suggests the level of experimentation is not undue.

(6) The Amount of Direction Provided:

The Examiner asserts that the level of direction provided weighs in favor of "undue experimentation". The Applicant reminds the Examiner that "[t]he amount of guidance or direction needed to enable the invention is inversely proportional to the amount of knowledge in the state of the art as well as the predictability in the art." See *In re Fisher*, 42 F.2d 833, 839 166 USPQ 18, 24 (CCPA 1970). See also M.P.E.P § 2164.03. "The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification." *Id.* As discussed above, it isn't magic, its just programming. As further evidenced by the Expert Declaration of Mr. Tipler, the art is extremely predictable. This factor clearly suggests the level of experimentation is not undue.

(7) The existence of working examples.

The Examiner is correct in his assertion that the specification does not point out the existence of working examples. The Examiner is reminded that "the absence of working examples will not by itself render the invention non-enabled." See M.P.E.P § 2164.02. This in no way

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

implies they do not exist. The Applicant is respectfully perplexed by the

Examiner's statement:

"[a]ssuming without conceding that the existence of working examples that were undisclosed in the original patent application is somehow relevant to the question of whether the applicants filed an enabling disclosure..."

The existence of working examples is one, (of many) factors to be considered. It is further important to note that "[c]ompliance with the enablement requirement of 35 U.S.C. 112 does not turn on whether and example is disclosed." M.P.E.P. 2164.02 Here, the Applicant reasserts in the supporting declaration of Mr. Bertos working Examples existed at the time of filing of the application. This factor clearly suggests the level of experimentation is not undue.

(8) The Quantity of Experimentation Needed:

The Examiner's response to argument included the statement that "this is mere argument without any supporting evidence." Applicant directs the Examiner's attention to the Expert Declaration of Mr. Tipler. Further, the Applicant reminds the Examiner that it isn't magic, it's just programming. Computer programming is a known art. The Applicant asserts that given the disclosure one of ordinary skill would not need to

Application No. 09/766,439

Betros et al.

Response to Office Action and Request for Reconsideration

“experiment” at all. This assertion is further supported by evidence. A person or ordinary skill would understand how to implement the present invention just by reading the specification. This factor clearly suggests the level of experimentation is not undue.

In light of the above discussion, it is respectfully submitted that the rejection is traversed. The claims in the application are clearly enabled by the specification. It is requested that the Examiner reconsider and withdraw the rejection.

Application No. 09/766,439


Betros et al.

Response to Office Action and Request for Reconsideration

Conclusion

Applicant believes that this Response has addressed all items in the Office Action and now places the application in condition for allowance. Accordingly, favorable reconsideration and allowance of all claims at an early date is solicited. Should any issues remain unresolved, the Examiner is invited to telephone the undersigned.

Respectfully submitted,
HELLER EHRMAN LLP

By: 
Steven A. Moore Esq., Ph.D.
Registration No. 55,462

Attorney Docket No. 43416-0003

Address all correspondence to:

Steven A. Moore

HELLER EHRMAN LLP

4350 La Jolla Village Drive, 7th Floor

San Diego, CA 92122-1246

Telephone: (858) 450-5767

Facsimile: (858) 450-8499

Email: steve.moore@hellerehrman.com